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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,190	04/19/2001	Steven Russell Day		1515

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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/839,190

Applicant(s)  
Day et al.

Examiner  
Vanaman

Art Unit  
3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 8, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11, and 14-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **Status of Application**

1. Applicant's amendment, filed April 8, 2002, has been entered in the application. Claims 1-6, 8-11 and 14-18 are pending, claims 7, 12 and 13 having been canceled.

### **Claim Objections**

2. Claim 3 is objected to because of the following informalities: in claim 3, lines 3 and 5 (two instances), it appears as though a comma (--,) should be inserted between "an end-wise margin" and "said end-wise margin". Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, lines 2 and 3 "said mounting surfaces" lack a clear antecedent basis; in view of the recitations of claim 4 (e.g., lines 2-3) and claim 6 (again, lines 2-3), it appears as though the recitation should be --said mounting bases--.

### **Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-6, 8-11 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez (US 2,330,147, cited and applied previously) in view of Bernstein (US 6,145,857). Rodriguez teaches a skateboard having a deck (1, 11) with a bottom surface (bottom of 1), front and rear ends (figure 1), a front pair of wheels (31) and a rear pair of wheels (31) both attached to trucks (e.g., 3a) having mounting bases (e.g., 18), the skateboard having a plate (2) connected to the bottom surface of the deck, within the periphery of the deck, and having a length substantially equal to the span between front and rear extents of the mounting bases of the wheel

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trucks, and having a width substantially equal to the respective widths of the mounting trucks, the plate being connected between the deck and wheel trucks, the mounting of the plate with respect to the wheel trucks and board being made by mounting hardware (e.g., 12, 15, 16) extending through a plurality of mounting apertures in the plate. The reference of Rodriguez fails to teach the truck mounting hardware as connecting the trucks *to the deck* through the holes in the plate. Bernstein teaches an accessory plate (12) for use with a skateboard (32, 34), wherein the mounting hardware for the trucks (e.g., 36) connects the trucks to the skateboard deck through apertures (26) in the accessory plate, the plate mounted to the board by the engagement of the trucks and deck. It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the trucks of Rodriguez directly to the skateboard deck through the apertures of the plate of Rodriguez, as suggested by the plate mounting technique of Bernstein, in order to (a) strengthen the mounting of the trucks to the deck, and (b) to simplify construction such that the trucks can be easily attached and removed without requiring access to the top-side of the plate.

As regards claims 2, 10, and 16, the reference of Rodriguez as modified by Bernstein fails to teach the plate as being made of a resilient plastic material. Resilient plastics are very well known in the manufacturing arts, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the plate from a plastic such as a polycarbonate, for the purpose of providing a plate which is both light weight and has a high impact strength, thus improving the life-span of the plate under use.

As regards claims 3, 11, 17 and 18, the reference of Rodriguez as modified by Bernstein fails to teach a specific thickness for the plate, however it is well known to adjust the thickness of structural members of a designed mechanism to meet a specific requirement, such as a height, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the thickness of the plate to between 0.1 and 0.33, or more specifically 0.25 inches, for

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the purpose of optimizing the height which is added to the skateboard by the use of the plate.

Note Rodriguez, page 2, col. 2, lines 13-17.

As regards claims 5, 6, 9, and 15, the reference to Rodriguez as modified by Bernstein fails to teach the length as being equivalent to the span between the ends of the mounting bases, and the width as being equivalent to the respective widths of the mounting bases, however it is well known to decrease the size of manufactured elements for the purposes of using lesser quantities of material, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to size the plate to be equal to the width and distal end span of the mounting bases of the wheel trucks for the purpose of achieving an incremental reduction in cost of manufacturing the board.

### **Response to Arguments**

6. Applicant's arguments concerning the reference of Rodriguez as previously applied by itself against the claims as originally written are noted. The examiner agrees. Note the reference to Bernstein, however, now applied in response to applicant's amendment of the claims.

As regards applicant's arguments directed to the use of a plastic material, In view of the provision of light weight, high strength plastics being well known in the art, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the plate from a high strength, light weight element in order to preserve a desired strength characteristic while reducing the vehicle's weight.

As regards applicant's comments concerning the 'reduced thickness' and the length and width of the plate, in that the specific thickness of the plate taught by Rodriguez is not disclosed, the examiner has not argued that it would be obvious to *reduce* the thickness of the plate, rather that it would be an obvious step to adjust the thickness of the plate to achieve a particular height of the deck above a ground surface. As regards the adjustment of dimensions and varying a scale characteristic of an element already taught by the prior art, where the general conditions of a

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claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et al.*, 33 CCPA (patents) 1250 156 F.2d 239, 70 USPQ 412, *Minnesota Mining and Mfg. Co. v. Coe*, 69 App D.C. 217, 99 F.2d 986, 38 USPQ 213; *Allen et al. v. Coe*, 77 App. D. C. 324 135 F.2d 11, 57 USPQ 136. Furthermore, substantial manufacturing savings may be had from the incremental reduction in the amount of material required in the production of a particular element (e.g., the length and width of the plate itself), and it is not deemed beyond the skill of the ordinary practitioner to reduce the width and length of the plate taught by Rodriguez as modified by Bernstein for the purpose of providing an incremental material cost reduction.

As regards the arguments that one of ordinary skill in the art would not see a 'slide plate', a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 3618.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents

Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry; informal or draft communications may be faxed to the same number but should be clearly labeled "UNOFFICIAL" or "DRAFT")

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**

F. Vanaman  
June 12, 2002



6/12/02